

### **Remarks**

Claims 3-24 and 27-30 are pending upon entry of the foregoing amendments. Claims 1, 2, 25, and 26 have been canceled. Claims 3 and 13 have been rewritten in independent form. Claims 4-7, 11, and 12 have been amended to depend from claim 3. Independent claim 15 has been amended to specify an *anodized or oxidized overcoating* primarily localized on each of the porosities at the top surface of the electrically conductive corrosion resistant coating as *discrete* amorphous structures. Support for this amendment is found in the specification at least at paragraph [0036] and Fig. 4E. No new matter has been added.

### **Information Disclosure Statement**

The undersigned respectfully requests that a copy of the initialed Electronic Information Disclosure Statement for the IDS submitted mailed September 3, 2003, be sent with the next Office communication.

### **Allowable Subject Matter**

Applicants thank the Examiner for indicating that claims 3, 7-10, 13-14, 17, and 21-24 would be allowable if rewritten in independent form including all of the limitations of the base claim. Accordingly, claims 3 and 13 have been rewritten in independent form and claims 4-7, 11, and 12 have been amended to depend from claim 3. Thus, Applicants respectfully submit that the subject matter of claims 3-7 and 11-14 are in condition for allowance.

### **Claim Rejections Under 35 U.S.C. § 102**

Claims 1-2, 4-5, 11-12, 15-16, 18-19, and 25 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,291,094 to Yoshimura et al. ("Yoshimura"). The rejection is respectfully traversed as applied to the amended claims.

Yoshimura discloses a gas separator for a fuel cell coated with a first coating layer including a first electrically conductive material and a second coating layer including a second electrically conductive material. Yoshimura discloses that the second coating layer may be formed through plating or press-fitting a material into a film or a sheet. In one embodiment, regions of the second coating layer are formed on the faces of the gas separator which contact the electrodes. Throughout Yoshimura, the second coating layer is only referred to as an electrically conductive material or a carbon material, such as thermal expansion graphite.

In contrast to amended claim 15, Yoshimura does not disclose or suggest an anodized or oxidized overcoating, which are discrete amorphous structures primarily localized on each of the porosities at the top surface of an electrically conductive corrosion resistant coating. Rather, Yoshimura discloses *plating or press-fitting* to form the second coating layer. These processes physically cover the first coating layer of Yoshimura, while *anodization and oxidation* chemically oxidize the electrically conductive corrosion resistant coating required by amended claim 15. Furthermore, disclosure in Yoshimura of *regions of the second coating layer on faces* provides no teaching or suggestion of an overcoating comprising *discrete amorphous structures primarily localized on each of the porosities* of an electrically conductive corrosion resistant coating. Amended claim 15 is therefore novel.

**Claim Rejections Under 35 U.S.C. § 103(a)**

Claims 6, 20, and 26-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshimura. The rejection is respectfully traversed as applied to the claims as amended.

Applicants submit that a *prima facie* case of obviousness has not been established because, as discussed above, Yoshimura does not disclose or suggest the limitations of amended claim 15.

In addition, a person of ordinary skill in the art would not have modified Yoshimura in the precise fashion claimed by Applicants in claims 20 and 27-30. “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.” KSR Int’l Co. v. Teleflex Inc., KSR Int’l Co. v. Teleflex Inc., 127 U.S. 1727, 1742 (2007). It is apparent that the selection of the materials posited by the Examiner to match the materials claimed by Applicants is only obtained using ex post reasoning.

The number of completely unrelated materials that have a high electric conductivity which do not form a passive state film or oxide film having no electric conductivity is unquestionably vast. The Examiner’s reasoning that a skilled artisan would choose titanium aluminum nitride for an electrically conductive corrosion resistant coating would only be obtainable by improper hindsight in view of claim 20. Likewise, the number of completely unrelated materials that are capable of being formed, through plating or the like, into a film on a surface of the base sheets is vast. Furthermore, Yoshimura only discloses that the second coating layer as an electrically conductive material or a carbon material. Thus, the modification of the second coating layer to include the particular oxides of claims 27-30 could only be derived from hindsight.

Moreover, the Supreme Court declared that a combination of elements may be obvious to try only “when there is a **design need or market pressure** to solve a problem **and there are a finite number of identified, predictable solutions** [and] a person of ordinary skill in the art has

good reason to pursue the known options within his or her technical grasp.” *Id.* No specific design need or market pressure has been given for why a person of ordinary skill in the art would modify Yoshimura so that the first coating layer includes titanium aluminum oxide and the second coating layer includes the particular oxides claimed by Applicants.

Therefore, Applicants claims are novel and nonobvious and the rejections should be withdrawn.

**Conclusions**

The claims as amended are patentable over the prior art of record. Prompt allowance of each of pending claims is therefore respectfully solicited.

The undersigned kindly invites the Examiner to contact her by telephone (404.853.8036) if any outstanding issues can be resolved by conference or examiner’s amendment.

Respectfully submitted,



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